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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,415	12/30/1999	DALE SANDBERG	3855.29	7821
21999	7590	09/12/2005	EXAMINER	
KIRTON AND MCCONKIE 1800 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE P O BOX 45120 SALT LAKE CITY, UT 84145-0120			BLECK, CAROLYN M	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/476,415

Applicant(s)

SANDBERG, DALE

Examiner

Carolyn M. Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-29, 31-38, and 40-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-29, 31-38, 40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 July 2005 has been entered.
2. This communication is in response to the RCE filed 8 July 2005. Claims 21-29, 31-38, and 40-41 are pending. Claims 21 and 33 have been amended.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 21-29, 31-38, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (5,924,074) in view of Feldon et al. (5,732,221), Lavin et al. (5,772,585), and Provost et al. (6,341,265).

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5. Claims 21-29, 31-38, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (5,924,074) in view of Feldon et al. (5,732,221) and Lavin et al. (5,772,585).

(A) As per claims 21- 22, 24-25, and 31-32, Evans discloses a medical records method and system for storage and retrieval of dynamic electronic medical records in a computer environment, such as a local or wide area network including portable computers (col. 1 lines 5-10), wherein patient data, such as patient complaints, lab orders, medications, diagnoses, and procedures, are captured at the point of care of a patient in real-time, such as during an examination or in hospital (see Figure 24), using a graphical user interface having touch screens in a point of care system (Abstract; lines 1-5; col. 2 lines 20-64, col. 5 lines 29-55, and col. 5 lines 8-10), comprising:

(a) selecting a procedure from a list of procedures administered by a physician of a healthcare facility, wherein the procedures reflect treatments of a physician, and wherein the procedures are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64);

(b) selecting a diagnosis from a list of diagnoses made by a physician of a healthcare facility, wherein the diagnosis indicates the proper administration of procedures to be performed by a physician, and wherein the diagnoses are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64);

(c) activating the form for use by a health care provider when diagnosing and performing a procedure or administering a treatment on a patient (Figures 1,5-6, 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64); and

(d) using the form to select a procedure, wherein the procedures reflect treatments of a physician, and wherein the procedures are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64) and to select a diagnosis from a list of diagnoses made by a physician of a healthcare facility, wherein the diagnosis indicates the proper administration of procedures to be performed by a physician, and wherein the diagnoses are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64).

Evans fails to expressly recite a "customizable form".

Feldon discloses entering a patient's demographic information, medical history, prescribed medication and other relevant information for a patient, including information a physician documents during the exam using exam descriptors, into data entry forms, wherein a user is able to customize these data entry forms by editing existing forms or by redesigning completely new forms, wherein the form is able to be saved using a computer (Figure 1, col. 4 lines 13-63, col. 8 lines 62-67, and col. 9 lines 15-65, col. 11 lines 1-58, and col. 12 lines 1-9).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the aforementioned features of Feldon within the method of Evans with the motivation of allowing forms to be generated based on the user's needs and customized for the particular task at hand (Feldon; col. 4 lines 52-54)

and transforming a patient chart from a static record of a few clinical interactions into a dynamic, real-time comprehensive record (Evans; col. 2 lines 34-40).

Evans and Feldon fail to expressly disclose patients wherein the step for generating the customizable form comprises: selectively defining display specifications that relate to at least one of :

- i) a display of the healthcare procedures characteristically performed by the particular healthcare provider and
- (ii) a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preference.

Lavin discloses creating a customized list for a health care provider's practice specialty, wherein the customized list relates to diagnoses and procedures used in the specialty (reads on "a display of the healthcare procedures characteristically performed by the particular healthcare provider" and "a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preference") (Figure 13, col. 9 lines 29-40). Further, Lavin discloses creating and viewing the customized list in a graphical user interface (reads on "customizable form") (Fig. 17, col. 3 line 65 to col. 4 line 17, col. 13 lines 28-59).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Lavin within the method taught collectively by Evans and Feldon with the motivation of maximizing the efficiency and

effective use of the physician's time (col. 15 lines 46-59) by providing customized lists created for a particular physician's practice specialty (Fig. 13).

Evans, Feldon, and Lavin fail to expressly disclose using the customizable form to display billing information prior to the rendering of the one of the procedures on the patient to allow the healthcare provider to advise the patient as to healthcare service to be rendered, including the most cost efficient healthcare alternative for the patient, and wherein the step for using the customizable to display billing information is performed during an examination of the patient, and wherein the step for using the customizable form to display billing information includes allowing the healthcare provider to selectively adjust the cost of rendering the one of the procedures at the time of the examination of the patient.

Provost discloses a claim form for entering patient information, including insurance plan information, diagnosis codes, treatment codes, wherein the dollar amounts for a treatment code are displayed, wherein the dollar amounts can be displayed in a short amount of time which is limited by data transmission rates, wherein the patient is able to present because the dollar amounts can be collected from the patient in the office, wherein the physician may provide alternative treatments which are approved for payment by an insurance plan (Abstract, Fig. 3, 4A, 4B, col. 8 line 32 to col. 12 line 14).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Provost within the method taught collectively by Evans, Feldon, and Lavin with the motivation of reducing the number of

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insurance claims that are rejected by an insurance company (Provost; col. 2 lines 27-57) and decreasing the amount of time to determine whether a claim will be paid (Provost; col. 2 lines 27-57).

(B) As per claim 23, Evans discloses a data interface permitting communication with external sources to obtain patient data and to transfer patient information to external health care providers, such as demographic data, laboratory test results, x-ray images, ICD9 diagnosis codes and CPT procedure codes, prescriptions for medications (col. 9 lines 1-14). The remainder of claim 23 repeats the same limitations as claim 21, and is therefore rejected for the same reasons given for claim 21, and incorporated herein. It is noted that the step of transferring patient information, including ICD9 diagnosis codes and CPT procedure codes, to external health care providers (col. 9 lines 1-14) is considered to be a form of "one or more other healthcare procedures or diagnoses used by another healthcare provider of a healthcare facility" as recited in claim 23.

(C) As per claim 26, Feldon discloses customizing data entry forms for a physician, for example for an examination of the eye by defining common types of eye exams (col. 1 line 20 to col. 2 line 12 and col. 4 lines 30-45). The remainder of claim 26 repeats the same limitations as claim 21, and is therefore rejected for the same reasons given for claim 21, and incorporated herein. The motivation for combining Feldon within Evans is given above in claim 21, and is incorporated herein.

(D) As per claim 27-29, Evans discloses entering and updating a patient record using a form, wherein the patient record includes insurance information, ICD9 diagnosis codes and CPT procedure codes, wherein upon entering and updating information, the electronic medical record system filed the patient's record in real-time in the patient data repository (Abstract, lines 1-2; Fig. 2-3, 5-6, and 14, col. 5 lines 1-27, col. 6 line 55 to col. 7 line 5, col. 9 lines 1-14).

It is noted that Evan's discloses recording insurance information as well as diagnosis and procedure codes within a patient record as discussed above (Abstract, lines 1-2; Fig. 2-3, 5-6, and 14, col. 5 lines 1-27, col. 6 line 55 to col. 7 line 5, col. 9 lines 1-14). As this information is most frequently used for billing purposes (i.e., billing insurance companies), it is respectfully submitted that this information within the patient record is a form of a "billing record." Furthermore, as per the recitation of "the billing record corresponding to standards in the industry," it is noted that ICD9 codes and CPT codes are widely accepted codes used to report and index medical records and are considered to be the standard codes set for reporting health care services in electronic data transactions.

(E) Claims 33-38 and 40-41 differ from method claims 21-29 and 31-32 by reciting hardware elements, namely, a computer readable medium and computer program code which is executable. As per these elements, Evans discloses:

(a) a multi-processor personal computer having 20 GB of storage capacity (col. 12 line 66 to col. 13 line 30); and

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(b) applications running under Microsoft ® Windows ™ to access data from a variety of data sources (col. 13 line 57 to col. 14 line 25).

Claim 33 has also been amended to recite "indicating any cost modification for the diagnosis or procedure indicated on the customizable form different from a cost typically billed by the particular healthcare provider for the diagnosis or the procedure indicated on the customizable form."

Provost discloses this feature. Note the teachings of col. 11 lines 19-49:

"When server system 14 informs client system 10 that a submitted claim is in a condition for payment, the server system can transmit information that specifies the amount that will be paid by the insurer on behalf of the patient. For example, claim form 12B of FIG. 3 includes a field 50 that displays a dollar amount when the server system has determined that the claim is in condition for payment. In the example of FIG. 3, fields 52 permit the medical technician to enter an amount that is requested for the treatments defined by the treatment codes in fields 46.

To illustrate, the medical technician might enter in field 46 a treatment code that represents a physical exam performed by a physician. The medical technician could then enter in field 52 a dollar amount, such as \$100, that is customarily charged by the physician for a physical exam. Field 54 sums all dollar amounts entered in fields 52. In this example, if the physical exam was the only treatment rendered to the patient, field 54 would also display a dollar amount of \$100. If the server system, when processing the submitted claim, determines that the patient's insurer pays only \$90 for a physical exam, field 50 displays the dollar amount of \$90 when the insurance claims has been processed and returned to the client system. A balance due field 56 displays the difference between the total charge field 54 and the amount paid field 50. The dollar amount displayed in field 56 represents the amount that is to be collected from the patient. As used herein, the term "co-payment" is defined to extend to the dollar amount displayed in field 56, representing the amount that is to be collected from the patient beyond the payment that is approved by the insurer."

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Provost within the method taught collectively by Evans, Feldon, and Lavin with the motivation of reducing the number of insurance claims that are rejected by an insurance company (Provost; col. 2 lines 27-

57) and decreasing the amount of time to determine whether a claim will be paid (Provost; col. 2 lines 27-57).

The remainder of claims 33-38 and 40-41 repeat the same limitations as claims 21-29 and 31-32, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

Response to Arguments

6. Applicant's arguments filed 8 July 2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed 8 July 2005.

(A) At pages 10-12 of the response filed 8 July 2005, Applicant argues that the nature of the problem to be solved is different from the applied prior art, and there is no motivation to combine the prior art.

In response to applicant's argument, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention. Note, for example, the motivation explicitly stated in the rejection of claim 22, which is based on the teachings of the applied prior art.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches a system and method for generating database input forms (5,619,708).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:


(703) 872-9306 or (703) 872-9326	[Official communications]
(703) 872-9327	[After Final communications labeled "Box AF"]
(571) 273-6767	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB

CB

August 26, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600